

REMARKS

(A) Status of the Application

(I) Disposition of Claims

- (i) Claims 1-10, and 12-19 are pending in the application.
- (ii) Claim 11 was previously canceled.
- (iii) Claims 1-10, and 12-19 are rejected.

(II) Applicant's Action

- (i) Applicant responds to the rejection.

(B) Rejection under 35 U.S.C. § 112, First Paragraph—Claims 1-10 & 12-19

The Examiner rejects Claims 1-10, and 12-19 under the written description requirement of 35 U.S.C. § 112, First Paragraph. The Examiner states that Claims 1-10, and 12-19, that is, all pending claims of the application, contain subject matter not described in the Specification in such a way as to reasonably convey to a skilled artisan that the inventor was in possession of the invention at the time he filed the patent application. Particularly, according to the Examiner, because the term “fluid passageway” lacks an antecedent basis in the Specification, and because the Specification fails to mention the spout having an internal slider that closes a fluid passageway, the meaning of the term fluid passageway is unclear. On this basis, Examiner asserts that all pending claims of the patent application fail to satisfy the written description requirement of 35 U.S.C. § 112, First Paragraph (the “112 rejection”). In view of the 112 rejection, the Examiner assumes the position to not examine the patent for its substantive merit.

Applicant respectfully disagrees with the Examiner and submits that the Examiner’s reasoning for the 112 rejection, and her position on inability to examine the patent application, are flawed.

(I) Why Examiner’s Reasoning is Erroneous-Antecedent Basis Issue

First, Applicant is surprised that the Examiner rejected ALL claims, even those that do NOT feature the term “fluid passageway.” In fact the term “passageway” occurs only in Claims 6, 8, and 12. Clearly, Claims 1-5, 7, 9, and 13-19 rejections are not even *prima facie* justified. Of course, this does not mean that Applicant implicitly admits the presence of 112 problem for Claims 6, 8, and 12. In fact, Applicant’s position is quite the opposite, as explained below. In light of this obvious error, at least for Claims 1-5, 7, 9, and 13-19, Applicant requests that the Examiner summarily withdraw the rejection.

Second, Applicant disagrees that fluid passageway “lacks adequate written description.”¹ For example, in Claim 6 as originally filed, Applicant does disclose a passageway from which fluid

¹ From MPEP § 2163 (III)(A):

A description as filed is presumed to be adequate, unless or until sufficient evidence or reasoning to the contrary has been presented by the examiner to rebut the presumption. See, e.g., *In re Marzocchi*, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971). The

can flow when the apertures of the external slider and ports of the internal slider are aligned. Clearly, a person skilled in the art would understand all of these terms as the external slider, the internal slider, the apertures, and the ports are discussed in the Specification. For reference, Applicant reproduces the originally filed Claim 6 below:

6. (ORIGINAL) A double slider valve for use in a fitment having a spout, the fitment for attachment to a container for holding and dispensing a fluid, the double slider valve comprising:
- a first generally cylindrical external slider movable axially within the spout; and
- a generally cylindrical internal slider movable axially within said external slider and having a series of ports located therein to allow the passage of fluid therethrough, said internal slider movable between a closed position operable to prevent the flow of fluid through the fitment and an open position in which the apertures and the ports are aligned and define a passageway through which fluid can flow, the internal slider being adapted to be moved between said closed and open positions by insertion of a dispensing connector into said external slider adjacent said internal slider; and
- biasing means for resiliently biasing said internal slider towards said closed position.

Thus, not only is it true that the highlighted portions of Claim 6 would be clear to a person of ordinary skill in the art, but also that the term passageway through which the fluid flows, does have antecedent basis in the original Specification. A person skilled in the art would easily understand that the external slider has apertures, that the internal slider has ports, and that the internal slider is axially positioned within the external slider. When the ports and the aperture align, the slider position is called an open position and fluid can flow through these ports and apertures. This, the Specification defines as a passageway for fluid flow. Also, because the term "passageway" is mentioned in original Claim 6 (and even if it had not been

examiner, therefore, must have a reasonable basis to challenge the adequacy of the written description. The examiner has the initial burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims. *Wertheim*, 541 F.2d at 263, 191 USPQ at 97. In rejecting a claim, the examiner must set forth express findings of fact regarding the above analysis which support the lack of written description conclusion. These findings should:

- (A) Identify the claim limitation at issue; and
- (B) Establish a *prima facie* case by providing reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed. A general allegation of "unpredictability in the art" is not a sufficient reason to support a rejection for lack of adequate written description.

mentioned) as filed, the original Claim 6 suffices as basis for support since even a claim is considered part of the Specification.²

Third, the term fluid passageway is clearly defined and discussed in Paragraph 42 of the Application. This paragraph is reproduced for Examiner's convenience:

[0042] Turning now to FIGS. 5A through 5C the internal slider 26 will now be described. Located on the internal slider 26 are a series of ports 64 that allow the passage of fluid therethrough when the internal slider 26 is in the open position. When in the open position, the ports 64 are in fluid communication with the apertures 53 between the posts 52 of the external slider 24, as can be seen more clearly in FIG. 7. (Emphasis added).

Fourth, as discussed in Paragraph 42 above, exemplary support for the term fluid passageway is also found in Figs. 5 and 7. Because drawings are construed as part of the Specification, contrary to the Examiner's assertions, the term fluid passageway does have antecedent basis.³

Thus, there are multiple reasons why first an antecedent basis as suggested by Examiner is not necessary, and second, even if necessary, why the antecedent basis is present in the Specification.

(II) Why Examiner's Position is Erroneous-Substantive Examination Not Performed

The Examiner expressed inability to conduct substantive examination until the 112 rejection was addressed. Applicant respectfully submits that the Examiner's position in this regard contradicts what the MPEP, § 2163 (I) recommends, that is, “[r]egardless of the outcome of the determination [whether the written description requirement of 35 U.S.C. § 112, First Paragraph, is satisfied], Office personnel must complete the patentability determination under all the relevant statutory provisions [§§ 101, 102, and 103] of title 35 of the U.S. Code.”

(III) Other Issues

Applicant also draws the Examiner's attention to the inappropriateness of the rejection based on 112 rejection at this point in prosecution of the case. Particularly, the prosecution has been under way for about four years, this being the fifth office action (from 03/2004). If the Examiner was of the opinion that the 112 rejection should be issued, such rejection should have been brought to the fore during the preliminary phase of the prosecution, and certainly in a previously issued action on the merits. However, at present, the prosecution has already been through two restriction/election requirements (03/03/2006 and 08/16/2007), one final rejection (04/06/2007), and an after-final amendment to the claims (07/06/2007). In previous office action, Applicant acceded to the restriction requirement simply to advance prosecution although Applicant had

² See MPEP § 2163 (I), citing *In re Koller*, 613 F.2d 819, 204 USPQ 702 (CCPA 1980) (original claims constitute their own description).

³ *Id.*, stating that, “[a]n applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. (*Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997).”

successfully traversed the same restriction requirement in a previous response to restriction. Applicant also shows surprise that even after successful traversal, the same restriction requirement was issued, and that too arising after a substantive examinations on merits. Finally, Applicant expresses surprise that the Examiner, in the present Office Action, declines to review the patent application on a substantive basis until the 112 problem is resolved, while a substantive examination has already been provided (in two rounds of prosecution) previously.

In light of the above discussion in (I) (II) and (III), Applicant requests the following:

- (i) a withdrawal of the 112 rejection, and
- (ii) a withdrawal of the present Office Action and a reissuance of an office action with substantive examination on the merits, or if Applicant's responses to previous substantive examination on merits have been satisfactory, a Notice of Allowance of the patent application.

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ATTORNEY DOCKET No.: **26090-034**

PATENT
GROUP ART UNIT 3754

CONCLUSION

In view of the above remarks, Applicant respectfully submits that stated grounds of rejection have been properly traversed, accommodated, or rendered moot and that a complete response has been made to Non-Final Office Action of January 28, 2008.

Therefore, Applicant believes that the application stands in condition for allowance with withdrawal of all grounds of rejection. Applicant respectfully solicits a Notice of Allowance.

If the Examiner has questions regarding the application or the contents of this response, the Examiner is invited to contact the undersigned at the number provided.

Under 37 C.F.R. § 1.136(a), this response also includes a petition for a one-month extension of time to respond to the Office Action. Should there be a fee due which is not accounted for, please charge such fee to Deposit Account No. 501447.

RESPECTFULLY SUBMITTED,

DATE: MAY 28, 2008

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